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HEWLETT-PACKARD COMPANY
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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT

PAPER NUMBER

2179

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,582

Applicant(s)

HAUSHEER ET AL.

Examiner

Doug Hutton

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>16 January 2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 2-8 are objected to because of the following informalities:

- the term “a” in Claim 2, Line 2 should be amended to — the — because the “plurality of the user’s Internet experiences” is previously mentioned in the claims (see Claim 1, Line 3); and
- the term “a” should be inserted between the terms “of” in Claim 5, Line 2 and “table” in Claim 5, Line 3 so that the limitation is grammatically correct.

Claim 16 is objected to because of the following informalities:

- The claim is awkwardly worded and appears to include a typographic error because of the phrase “one of:” in Line 2. Additionally, the limitation “*compiling and publishing the user decisions and outcomes for a selected portion of the set of interactive user Internet sessions*” has already been set forth in Claim 11, Lines 5-6. Claim 16 should be amended to the following: “The method of claim 11, wherein the set of the interactive user Internet sessions includes incorporating advertising on printed pages in accordance with a predetermined scheme.” For purposes of examination, the examiner will assume that the claim is set forth to indicate that advertising may be incorporated on the printed pages.

Claim 18 is objected to because of the following informalities:

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- the term “a” in Line 2 should be amended to — the — because the “plurality of the user’s Internet experiences” is previously mentioned in the claims (see Claim 17, Lines 3-4).

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 and 17-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-9:

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Additionally, the claimed invention is so abstract and sweeping that it covers the method as practiced by a human operator assisted only by pencil and paper. The claims do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a “mental process,” is not patentable subject matter.

"Phenomena of nature, though just discovered, "*mental processes*," abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (emphasis added) *Gottschalk v. Benson*, 75 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing* U.S.P.Q. 571 (1969).

Applicant may obviate these rejections by amending Claim 1 to read: "A **computerized** method" (see Line 1).

Claims 17-31:

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

The claims recite a "computer program" that comprises "programming instructions," but do not recite that the program or the instructions are "tangibly embodied on a computer-readable medium." Thus, the invention is not tangible, as required under 35 U.S.C. 101. Additionally, as currently recited in the claims, the "computer program" and the "programming instructions" may be written on a piece of paper. In this context, the invention is not technical.

Applicant may obviate these rejections by amending Claims 17 and 28 to read: "A computer program ***tangibly embodied on a computer-readable medium***" (see Claims 17 and 28, Line 1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, 9-20, 22-24 and 26-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Glezerman, U.S. Patent Application Publication No. US 2003/0207237 (see Figures 1-4; see Paragraphs 0001-0080; see Claims 1-24).

Claim 1:

Glezerman discloses a method for collating experiences of an interactive user Internet session (see Abstract – Glezerman discloses this limitation in that the system collects data concerning Internet use for a user), comprising the steps of:

- archiving a plurality of a user's Internet experiences in correspondence with correlated decisions and outcomes (see Abstract – Glezerman discloses this limitation in that the system accumulates data concerning a user's interactions and movements within a controlled environment); and
- arranging the decisions and outcomes in accordance with a predetermined scheme (see Abstract – Glezerman discloses this limitation in that the system controls the environment presented to the user through preset parameters).

Claim 2:

Glezerman discloses the method of Claim 1, further including a step of printing a selected portion of a plurality of the user's Internet experiences in accordance with a selected printing option (see Abstract – Glezerman discloses this limitation in that the system provides reports to a guardian concerning the user's interactions and movements within the controlled environment).

Claim 3:

Glezerman discloses the method of Claim 2, wherein the selected portion is one of:

- a partial sequence of the user's Internet experiences (see Abstract – Glezerman discloses this limitation in that the system provides reports to a guardian concerning a portion of the user's interactions and movements within the controlled environment);
- a sequence of the user's Internet experiences that comprises a logical unit (see Abstract – Glezerman discloses this limitation in that the system provides lessons to the user); and
- a sequence of the user's Internet experiences that comprises a start-to-finish compilation of a multi-step activity of the user (see Abstract – Glezerman discloses this limitation in that the system provides activities for the user within the controlled environment).

Claim 5:

Glezerman discloses the method of Claim 3, wherein the selected printing option includes, for the start-to-finish compilation, dynamically generating one of a table of contents and an index (see Paragraph 0033 – Glezerman discloses this limitation in that the system allows the guardian to set the format of the reports).

Claim 6:

Glezerman discloses the method of Claim 3, wherein the selected printing option includes one of :

- dynamically generating images to accompany written information for the start-to-finish compilation (see Paragraph 0047 – Glezerman discloses this limitation in that the system provides an environment that includes both text and images);
and
- dynamically selecting images to accompany written information for the start-to-finish compilation (see Paragraph 0023-0025 and 0052 – Glezerman discloses this limitation in that the system allows a user to select the parameters for the controlled environment and provides an agent to dynamically insert text and images).

Claim 7:

Glezerman discloses the method of Claim 3, wherein the selected printing option includes, for the start-to-finish compilation, dynamically generating a listing of related

further reading (see Paragraph 0033 – Glezerman discloses this limitation in that the system provides expert counsel by a virtual psychologist to the guardian. This disclosure suggests that the counsel may be provided by “generating a listing of related further reading.”).

Claim 9:

Glezerman discloses the method of Claim 1, wherein the arranging step further comprises arranging a start-to-finish compilation in a non-book format (see Paragraph 0077 – Glezerman discloses this limitation in that the system may comprise a variety of media including audio and video).

Claim 10:

Glezerman discloses the method of Claim 9, wherein the arranging step further comprises generating an audio stream (see Paragraph 0077 – Glezerman discloses this limitation in that the system may comprise a variety of media including audio).

Claim 11:

Glezerman discloses a method of providing and managing a pick-a-path experience for a set of interactive user Internet sessions (see Abstract – Glezerman discloses this limitation in that the system provides a controlled virtual environment for a user), comprising the steps of:

- archiving user decisions and outcomes of the interactive user Internet sessions (see Abstract – Glezerman discloses this limitation in that the system accumulates data concerning a user's interactions and movements within a controlled environment); and
- compiling and publishing the user decisions and outcomes for a selected portion of a complete set of the interactive user Internet sessions (see Abstract – Glezerman discloses this limitation in that the system provides reports to a guardian concerning the user's interactions and movements within the controlled environment).

Claim 12:

Glezerman discloses the method of Claim 11, wherein the pick-a-path experience is one of: an educational experience, a simulation, an entertainment experience and a gaming experience (see Paragraph 0001 – Glezerman discloses this limitation in that the system provides learning and entertainment software within a virtual learning and playing environment).

Claim 13:

Glezerman discloses the method of Claim 11, wherein the pick-a-path experience includes a plurality of activity goals (see Paragraphs 0005-0006 – Glezerman discloses this limitation in that the system guides the user to learning activities and presents to the user one or more sets of selectable activities).

Claim 14:

Glezerman discloses the method of Claim 13, wherein the step of compiling and publishing includes publishing user decisions and outcomes that have been archived for at least one of the activity goals (see Abstract – Glezerman discloses this limitation in that the system provides reports to a guardian concerning the user's interactions and movements within the controlled environment).

Claim 15:

Glezerman discloses the method of Claim 11, wherein the pick-a-path experience incorporates user interactivity and is designed to include content that provides cliff-hanger anticipation to attract users to a hosting website (see Paragraphs 0010-0011 – Glezerman discloses this limitation in that the system prompts the user to an activity. The system prompts the user to an activity by offering a prize if the user satisfies a goal.).

Claim 16:

Glezerman discloses the method of Claim 11, wherein the set of the interactive user Internet sessions includes incorporating advertising on printed pages in accordance with a predetermined scheme (see Paragraphs 0025 and 0059 – Glezerman discloses this limitation in that the system delivers banner ads to the user and includes all banner ads selected by the user in the report).

Claims 17-19, 22, 24, 26-29 and 31:

Claims 17-19, 22, 24, 26-29 and 31 merely recite computer software that performs the methods of Claims 1-3, 5, 7, 9-12 and 16, respectively. Glezerman discloses computer software that performs the methods of Claims 1-3, 5, 7, 9-12 and 16 (see Paragraph 0001). Thus, Glezerman discloses every limitation of Claims 17-19, 22, 24, 26-29 and 31, as indicated in the above rejections for Claims 1-3, 5, 7, 9-12 and 16.

Claim 20:

Glezerman discloses the computer program of Claim 19, further including programming instructions for dynamically altering the start-to-finish compilation to incorporate custom, personalized characters (see Abstract – Glezerman discloses this limitation in that the system includes a visible “buddy” to guide the user within the controlled environment).

Claim 23:

Glezerman discloses the computer program of Claim 19, further including programming instructions for one of:

- dynamically selecting images to accompany the selected portion of the plurality of the user's Internet experience (see Paragraph 0023-0025 and 0052 – Glezerman discloses this limitation in that the system allows a user to select the parameters for the controlled environment and provides an agent to dynamically insert text and images); and

- dynamically generating images to accompany the selected portion of the plurality of the user's Internet experience (see Paragraph 0047 – Glezerman discloses this limitation in that the system provides an environment that includes both text and images).

Claim 30:

Glezerman discloses the computer program of Claim 29, further including publishing instructions for publishing user decisions and outcomes that have been archived for at least one educational goal (see Abstract; see Paragraph 0001 – Glezerman discloses this limitation in that the system provides learning software within a virtual learning environment and provides reports to a guardian concerning the user's interactions and movements within the controlled environment).

Claim 32:

Glezerman discloses a memory unit wherein the computer program of Claim 28 is stored thereon (see Figure 1; see Paragraph 0020 – Glezerman discloses this limitation in that the system provides a virtual learning environment stored on a server).

Claim 33:

Glezerman discloses the memory of Claim 32, wherein the memory unit is one of: a compact disc, a hard drive of a computer, a floppy disk, and a memory unit of a

shared database (see Figure 1; see Paragraph 0020 – Glezerman discloses this limitation in that the system provides a virtual learning environment stored on a server).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 8, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glezerman, in view of Blumberg et al., U.S. Patent Application Publication No. US 2003/0140315 (see Figures 1-6; see Paragraphs 0001-0229; see Claims 1-62).

Claim 4:

As indicated in the above rejection, Glezerman discloses every limitation of Claim 3. Glezerman also discloses the method of Claim 3, wherein the selected printing option includes, for the start-to-finish compilation, dynamically generating a report (Glezerman discloses this limitation in that the system provides reports to a guardian concerning the user's interactions and movements within the controlled environment, as indicated in the above rejection for Claim 2).

Glezerman fails to expressly disclose dynamically generating at least one of a front and a back book cover.

Blumberg teaches dynamically generating at least one of a front and a back book cover for the purpose of allowing a user to interactively finish and view a finished document (see Paragraph 0009).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Glezerman, to include a printing option, for the start-to-finish compilation, that includes dynamically generating at least one of a front and a back book cover, for the purpose of allowing a user to interactively finish and view a finished document, as taught by Blumberg.

Claim 8:

As indicated in the above rejection, Glezerman discloses every limitation of Claim 3. Glezerman also discloses the method of Claim 3, wherein the selected printing option includes, for the start-to-finish compilation, dynamically generating a report (Glezerman discloses this limitation in that the system provides reports to a guardian concerning the user's interactions and movements within the controlled environment, as indicated in the above rejection for Claim 2).

Glezerman fails to expressly disclose dynamically generating a preselected book feature.

Blumberg teaches dynamically generating a preselected book feature stored in a job description file, for the purpose of giving a user an alternative to interactively selecting the finishing options for the document (see Paragraph 0010).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Glezerman, to include a printing option, for the start-to-finish compilation, that includes dynamically generating a preselected book feature, for the purpose of giving a user an alternative to interactively selecting the finishing options for the document, as taught by Blumberg.

Claims 21 and 25:

Claims 21 and 25 merely recite computer software that performs the methods of Claims 4 and 8, respectively. Both Glezerman (see Paragraph 0001) and Blumberg (see Paragraph 0010) disclose computer software that performs the methods of Claims 4 and 8. Thus, Glezerman, in view of Blumberg discloses/teaches every limitation of Claims 21 and 25, as indicated in the above rejections for Claims 4 and 8.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Rubin et al., U.S. Patent No. 6,820,111; Levin et al., U.S. Patent Application Publication No. US 2003/0101090; Vigue et al., U.S. Patent Application Publication No. US 2004/0095378; Comroe, U.S. Patent Application Publication No. US 2001/0047362; Chiang et al., U.S. Patent No. 6,674,447; http://www.writenews.com/2001/032101_hungryminds_alacarte.htm, published 21 March 2001; and <http://www.microsoft.com/presspass/press/2001/may01/05-14CusomBookPR.asp>, published 14 May 2001.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
May 27, 2005



**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**